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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,190	03/12/2004	Imad Tarabishy	V-3301-023	8186

7590

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EXAMINER

BLANCO, JAVIER G

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/799,190	Applicant(s) TARABISHY, IMAD	
	Examiner Javier G. Blanco	Art Unit 3738	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of **Prosthesis: Species C** (Figure 15) and **Methods: Species A** (Figures 21, 22) in the reply filed on December 27, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 1-4 are readable on the elected species.

### *Oath/Declaration*

3. The (supplemental) oath or declaration, filed March 12, 2004, is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.
  - a. The oath or declaration is defective because the file does not contain an amendment filed on July 12, 2002. According to PALM and eDAN systems, no preliminary amendment was filed on July 12, 2002.

### *Specification*

4. The disclosure is objected to because of the following informalities:
  - a. Please update the CROSS-REFERENCE TO RELATED APPLICATIONS section (i.e., now US 6,755,865). Also, according to PALM and eDAN systems, there is no preliminary amendment filed on July 12, 2002. Appropriate correction is required.

Art Unit: 3738

b. The BRIEF DESCRIPTION OF THE DRAWINGS section does not have a brief description of Figures 35-57. Appropriate correction is required.

### *Abstract*

5. The abstract of the disclosure is objected to because the form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. Correction is required. See MPEP § 608.01(b).

### *Drawings*

6. The drawings are objected to because reference legend 38B have been used to designate two different figures. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

Art Unit: 3738

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 1, (i) “the lateral side” (see line 4), (ii) “the femur” (see line 4), and (iii) “the hip bone” (see line 7) lack antecedent basis. Claims 2-4 depend on claim 1.

b. Regarding claim 2, the limitation “said ball, a neck, a body” (see line 2) is confusing since claim 1 already introduced shaft 114 as having a body 120, a neck 122, and a ball 110; rendering claim 2 vague and indefinite.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grimes (WO 00/48535 A1).

Art Unit: 3738

Referring to all Figures, specifically Figures 29 and 30, Grimes discloses a joint prosthesis comprising (a) a shaft (stem 613) having a first end and a second end, said shaft comprising a body, a neck attached to said body and a ball attached to said neck, said shaft being *sized and configured to* be receivable from the lateral side of the femur in a hole bored through the greater trochanter of a prepared femur of a patient; and (ii) a prosthetic acetabulum being *sized and configured for* attachment to a prepared area on the hip bone of the patient, said acetabulum comprising a cup, said cup having an interior surface that is *sized and configured to* receive said ball of said shaft for movement therein (see page 17, lines 28-31; page 30, lines 22-24).

Said shaft further comprising: (i) at least one tube (primary channel 616) having first and second open ends and extending from the bottom surface of said body and opening through said neck (see Figures 29 and 30); (ii) a second tube (primary channel 614) having an open end extending from the bottom surface of said body and a second closed end (see Figures 29 and 30); and secondary tubes (secondary channels 635-639) passing through a side wall of said body and through said second tube such that said secondary tubes are in fluid communication with said second tube (see Figures 29 and 30; see page 46, lines 7-24).

#### ***Allowable Subject Matter***

11. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3738

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Malcom et al. (US 4,274,163 A), Klaue et al. (5,376,123 A), Johnson (US 5,571,195 A), Harle (US 5,693,099 A), Schenck et al. (US 5,702,446 A), and Muñoz (ES 2 067 422 A1).

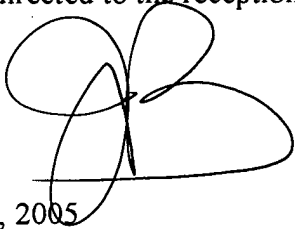
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

January 21, 2005



David H. Willse  
Primary Examiner